

Serial No. 10/710,0317  
Attorney Docket No. 70655.1900

### **REMARKS**

Applicants reply to the Office Action mailed on February 9, 2006, within the shortened statutory period for reply. Claims 1-46 were pending and the Examiner rejects claims 1-46. In reply, Applicants amend various claims, add new claims 47-52, and address the Examiner's remarks. Thus, claims 1-52 are now pending in the application. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

### **Double Patenting**

The Examiner provisionally rejects claims 1-46 over claims 1-46 of co-pending Patent Application Serial No. 10/708,828. While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this provisional non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

### **Claim Rejections**

#### **§102 Rejections**

Claims 1-4, 11, 13-15, 20, 22-24, 26, 28, 34, 35, 37-39 and 42 are rejected under 35 U.S.C. §102(3) as being anticipated by Black U.S. 2005/0122209 ("Black").

While Black may disclose various transaction and biometric security technologies, Black does not disclose or suggest at least a "device further configured to determine whether said proffered signature scan sample is associated with a preset transaction limitation independent of a financial account transaction limitation" as recited in claim 1 and as similarly recited in claims 22 and 34.

Accordingly, Applicants assert that claims 1, 22 and 34 are patentable over the cited reference. Similarly, claims 2-4, 11, 13-15, 20, 23-24, 26, 28, 35, 37-39 and 42 variously depend

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from claims 1, 22 and 34 and contain all of the respective elements thereof. Therefore, Applicants respectfully submit that claims these are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of these claims under §102.

### §103 Rejections

Claims 5-9, 12, 19, 21, 25, 27, 29, 30, 32, 33, 36, 40 and 43-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Black, as discussed above. Claims 15, 32 and 40 stand rejected over Black in view of Martizen, et al. U.S. 2002/0191816 ("Martizen"). Claims 10, 31 and 41 stand rejected over Black in view of Black U.S. 6,307,956 ("Black II"). Claim 16 stands rejected over Black/Martizen in view of Moebs U.S. 2005/0065872 ("Moebs"). Claim 17 stands rejected over Black in view of Teicher U.S. 6,257,486 ("Teicher"). Claim 18 stands rejected over Black in view of Goodman U.S. 2002/0043566 ("Goodman").

While Black, Martizen, Black II, Moebs, Teicher, and Goodman may disclose various transaction and biometric security technologies, neither Black, Martizen, Black II, Moebs, Teicher, Goodman, nor any combination thereof, disclose or suggest at least a "device further configured to determine whether said proffered signature scan sample is associated with a preset transaction limitation independent of a financial account transaction limitation" as recited in claim 1 and similarly recited in claims 22 and 34.

Accordingly, Applicants assert that claims 1, 22 and 34 are patentable over the cited references. Similarly, claims 2-21, 23-33 and 35-46 variously depend from claims 1, 22 and 34 and contain all of the respective elements thereof. Therefore, Applicants respectfully submit that claims these are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-46.

### NEW CLAIMS 47-52

New claims 47-52 variously depend from claims 1, 22 and 34 and contain all of the respective elements thereof. Therefore, Applicants assert that new claims 47-52 are

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differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

### CONCLUSION

Applicants respectfully submit that the pending claims (52 total, 3 independent) are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

Dated: Apr. 24, 2006

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